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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/802,797	03/09/2001	Jon Marcus Randall Whitten	MS1-768US	8294

22801 7590 07/24/2003

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EXAMINER
JONES, SCOTT E

ART UNIT	PAPER NUMBER
3713	

DATE MAILED: 07/24/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/802,797	RANDALL WHITTEN ET AL.	
	Examiner	Art Unit	
	Scott E. Jones	3713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *13 May 2003* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-52,57,58 and 60-71* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-52,57,58 and 60-71* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *09 March 2001* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *10* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Response to Amendment

1. This office action is in response to the request for reconsideration filed on May 13, 2003 in which applicant cancels claims 53-56 and 59, and responds to the claim rejections.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 13, 2003 has been entered.

Election/Restrictions

3. Claims 53-56 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, Group II, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 11.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-9, 12-19, 21-22, 24-25, 27, 34-35, 43, 48, 50-52, 57-58, 60, and 61-71 are rejected under 35 U.S.C. 102(e) as being anticipated by Tanaka (U.S. 6,299,535).

Tanaka discloses a method of processing an interactive game, a program product, and a game system which enables players to play video games. Tanaka discloses:

Regarding Claims 1, 13, 15, 22, 27, 34, 35, and 57:

- a processor (**12**) (Fig. 1);
- a hard disk drive (**15**) coupled to the processor, the hard disk drive being configured to store various game data (Fig. 1, Column 3, lines 54-55, and Column 13, lines 9-18).

Regarding Claims 2 and 16:

- a memory (**13**) (**14**) coupled to the processor (Fig. 1).

Regarding Claim 3:

- a portable media drive (**18**) (**30**) coupled to the processor and configured to communicate with a storage disc (Fig. 1).

Regarding Claims 4, 17, 57, and 60:

- a console application stored on the hard disk drive and executable on the processor, the console application configured to implement a user interface to the gaming system (Column 3, lines 54-55, and Column 13, lines 9-18).

Regarding Claim 5:

- a portable memory unit (**31**) coupled to the processor (Fig. 1, and Column 4, lines 11-14).

Regarding Claims 6, 24, 27, 34, 35, 43, and 48:

- the hard disk drive is configured to store game data, audio data, and video data (Column 3, lines 53-54, Column 13, lines 9-18, and Column 5, lines 31-51).

Regarding Claims 7, 19, and 58:

- the hard disk drive is segregated into a plurality of regions, each region for storing a particular type of data (Column 3, lines 53-54, Column 13, lines 9-18, and Column 5, lines 31-51).

Regarding Claims 8, 18, 21, and 25:

- the hard disk drive is segregated into a user data region, an application region, and a console application region (Column 3, lines 53-54, Column 13, lines 9-18, and Column 5, lines 31-51).

Regarding Claim 9:

- the hard disk drive is segregated into a settings region, a user data region, an application region, a utility region, and a console application region (Column 3, lines 53-54, Column 13, lines 9-18, and Column 5, lines 31-51).

Regarding Claims 12, 13, 14, 43, 48, and 50-52:

- the game console boots into a console application stored on the hard disk drive. Inherently, computers have boot executable programs that have start-up routines upon providing power to a computer.

6. Claims 1, 10-11, 13, 18, 20, 22-23, 26-33, 36-43, 44-49, and 57 are rejected under 35 U.S.C. 102(b) as being anticipated by Links 386CD Players Manual.

Links 386CD Players Manual discloses golf video game played on a game console (personal computer) having a hard disk drive and memory. Links 386CD Players Manual discloses:

Regarding Claims 10, 23, 45, and 49:

- the hard disk drive is configured to store data associated with multiple saved games (Page 45).

Regarding Claims 11, 26, 32, 33, 36, 37, 38, 39, 40, 42, and 44:

- retrieving, displaying, and allowing a user of the gaming system to select and/or create a nickname (player name) from/in the Player List Box (Page 19).

Regarding Claim 20:

- the hard disk drive is configured to store saved game data such that the saved game data associated with a particular game is stored separately from saved game data associated with other games (Pages 44-45).

Regarding Claim 41:

- automatically entering the selected nickname into a high score display (score card) (Page 28).

Regarding Claim 28:

- saving a current state of a game to the hard disk drive in response to a save game request (Pages 44-45).

Regarding Claims 29, 30, and 31:

- retrieving a list of saved games associated with the game installed in the gaming system (Pages 44-45).

Regarding Claims 46 and 47:

- the game console boots into a console application stored on the hard disk drive. Inherently, computers have boot executable programs that have start-up routines upon providing power to a computer.

Response to Arguments

7. Applicant's arguments filed May 13, 2003 have been fully considered but they are not persuasive.

8. Applicant respectfully traverses the rejection to claims 1-9, 12-19, 21-22, 24-25, 27, 34-35, 43, 48, 50-52, 57-58, and 60-71 under 35 U.S.C. 102(e) as being anticipated by Tanaka (U.S. 6,299,535).

Regarding claim 1, applicant alleges Tanaka fails to disclose or suggest "...a hard disk drive that is non-removable from the game console and that stores a console application to which the game console boots..."

However, the examiner respectfully disagrees. Regarding claim 1, most all computer systems, including Tanaka's game system, boot into an application stored on the hard disk drive, or any other type of disk drive or other portable memory device for that matter. Therefore, Tanaka anticipates claim 1.

9. Applicant alleges claims 2-9 and 12 are allowable because each claim is dependant upon claim 1. However, applicant's arguments amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

10. Applicant alleges claims 13, 43, 61, and 67-69 are allowable for at least the reasons provided for claim 1. However, the examiner respectfully disagrees. Please see item number 8 above. Furthermore, claim 13 states, "a hard disk drive coupled to the processor, the hard disk drive being configured to boot the game console..." Again, most all computer systems, including Tanaka's game system, are configured to boot into a console application stored on the hard disk drive, or any other type of disk drive or other portable memory device for that matter.

Claim 43 states, "booting a game console from a non-removable hard disk drive integrated into the game console..." However, the claim does not explicitly state that the boot program is stored on the hard disk drive, and therefore does not preclude that the hard disk drive is configured to retrieve these instructions from the boot program stored on ROM, disk drive or other portable memory device for that matter.

Additionally, applicant alleges Tanaka is not described specifically with respect to a video game console for playing video games, and more particularly is not taught as initially loading a video game program in the boot sequence. First, Tanaka's video game system, or personal computer, etc. is equivalent to applicant's game console. Second, Tanaka's device can run many other applications in addition to executing instructions to play a video game. Third, to one having ordinary skill in the art at the time of applicant's invention, it was notoriously well known that computers can be booted directly from various electronic storage media, such as, from the ROM, CD-ROM, floppy disk, hard disk drive, or other portable memory device for that matter. For instance, upon powering up computers, these systems are configured to scan other internal disk drives. The normal boot program is overridden upon detecting a disk having boot instructions in one of the other drives upon powering up. One reason this sequence is followed is

because a computer may crash and not be able to re-boot unless a user installs an "emergency boot disk" in one of the drives. Therefore, Tanaka anticipates claims.

11. Regarding claim 22, applicant alleges Tanaka fails to disclose or suggest "...segregating user data on the hard disk associated with one video game from user data and application data on the hard disk drive associated with other video games..." The examiner respectfully disagrees. In particular, as previously stated in Office Action, Paper No. 5, Tanaka discloses, "the game program or image data may be stored on hard disk drive (15) (column 3, lines 54-55, and column 13, lines 9-18). Inherently, game program data is saved in various files. Separate files are equivalent to segregating data, such as, user data and application data, on a hard disk. Therefore, Tanaka anticipates the claim.

12. Applicant alleges claims 24 and 25 are allowable because each claim is dependant upon claim 22. However, applicant's arguments amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

13. Regarding alleges claim 57 is patentable for at least the reasons provided for claim 22. However, the examiner respectfully disagrees. Please see item number 11 above.

14. Regarding claim 27, applicant alleges Tanaka fails to disclose or suggest, "preventing the video game from accessing portions of the hard disk drive that are not associated with the video game. The examiner respectfully disagrees. Tanaka discloses a video game system which executes a game program. Game programs inherently contain executable instructions to open/close/use etc. various files stored in memory. Inherently, a game program is only going to request files called by the executable instructions and associated with the video game.

Therefore, inherently, the video game would not access portions of the hard disk drive that are not associated with the game. Therefore, Tanaka anticipates claim 27.

15. Applicant alleges claims 34 and 35 are allowable because each claim is dependant upon claim 27. However, applicant's arguments amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

16. Regarding claim 48, applicant alleges Tanaka fails to disclose or suggest, "wherein the game console will not operate unless the hard disk drive is functioning..." However, the examiner respectfully disagrees. As previously stated in Office Action, Paper No. 5, Tanaka discloses, "program data may be stored on hard disk drive (15)." Therefore, since Tanaka's hard disk drive stores program data required to execute the game, it suffices to say that if Tanaka's hard disk drive is not functioning, then Tanaka's game console (11) will not operate properly. Therefore, Tanaka anticipates claim 48.

17. Applicant traverses the rejection to claims 1, 10-11, 13, 18, 20, 22-23, 26-33, 36-43, 44-49, and 57 under 35 U.S.C. 102(b) as being anticipated by Links 386CD Players Manual.

Regarding claims 1, 13, 18, and 43, applicant alleges Links 386CD Players Manual fails to disclose or suggest a game console that boots into a console application stored on a hard disk drive in a game console. However, the examiner respectfully disagrees. Regarding claims 1, 13, 18, and 43, most all computer systems, including a Links 386CD game system, boot into an application stored on the hard disk drive, or any other type of disk drive or other portable memory device for that matter. Therefore, Links 386CD Players Manual anticipates claims 1, 13, 18, and 43.

18. Applicant alleges claims that depend from claims 1, 13, 18, and 43 are allowable. However, applicant's arguments amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

19. Regarding claims 22 and 57, applicant alleges Links 386CD Players Manual fails to disclose or suggest "segregating user data and application data on the hard disk drive associated with one video game from user data and application data on the hard disk drive associated with other video games." The examiner respectfully disagrees. Inherently, game program data (user data and application data) is saved into various files. Separate files are equivalent to segregating data, such as, user data and application data, on a hard disk. Therefore, Links 386CD Players Manual anticipates claims 22 and 57.

20. Regarding claim 27, applicant alleges Links 386CD Players Manual fails to disclose or suggest, "preventing the video game from accessing portions of the hard disk drive that are not associated with the video game. The examiner respectfully disagrees. Links 386CD Players Manual discloses a video game system which executes a game program. Game programs inherently contain executable instructions to open/close/use etc. various files stored in memory. Inherently, a game program is only going to request files called by the executable instructions and associated with the video game. Therefore, inherently, the video game would not access portions of the hard disk drive that are not associated with the game. Therefore, Links 386CD Players Manual anticipates claim 27.

21. Applicant alleges claims 28-33 are allowable because each claim is dependant upon claim 27. However, applicant's arguments amount to a general allegation that the claims define a

patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

22. Regarding claim 36, applicant alleges Links 386CD Players Manual fails to disclose the use of "nicknames" as recited in claim 36. However, the examiner respectfully disagrees. In Links 386CD Players Manual, a user "creates" a new player(s) when the game is played for the very first time (pp. 19-20). However, for subsequent games, a user may select from a list of players that have been previously created in the "player list box" (pp. 19-20). The names created for players listed in the "player list box" do not preclude the use of nicknames. Therefore, Links 386CD Players Manual anticipates claim 36.

23. Applicant alleges claims 37-42 are allowable because each claim is dependant upon claim 36. However, applicant's arguments amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

24. Regarding claim 48, applicant alleges Links 386CD Players Manual fails to disclose or suggest, "wherein the game console will not operate unless the hard disk drive is functioning..." However, the examiner respectfully disagrees. Links 386CD Players Manual discloses a video game system which executes a game program. Therefore, since a Links 386CD video game system hard disk drive stores program data required to execute the game, it suffices to say that if a Links 386CD hard disk drive is not functioning, then a Links 386CD game console (personal computer) will not operate properly. Therefore, Links 386CD Players Manual anticipates claim 48.

25. Therefore, for the reasons discussed hereinabove, the examiner maintains the rejection to claims 1-9, 12-19, 21-22, 24-25, 27, 34-35, 43, 48, 50-52, 57-58, and 60-71 under 35 U.S.C. 102(e) as being anticipated by Tanaka (U.S. 6,299,535) and the rejection to claims 1, 10-11, 13, 18, 20, 22-23, 26-33, 36-43, 44-49, and 57 under 35 U.S.C. 102(b) as being anticipated by Links 386CD Players Manual.

Conclusion

26. All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott E. Jones whose telephone number is (703) 308-7133. The examiner can normally be reached on Monday - Friday, 8:30 A.M. - 5:30 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael O'Neill, Acting SPE can be reached on (703) 308-1148. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

SEJ
sej
July 22, 2003

MICHAEL O'NEILL
PRIMARY EXAMINER